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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,995	10/20/2000	Dean F. Jerding	A-6687	8091

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EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2614	6

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/692,995	JERDING ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-75* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-75* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 October 2000* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

In consideration of applicant's claim for priority with respect to provisional application 60/170,302, the provisional application generally introduces the concept of a bookmark in conjunction with the "current rental screen" (Page 13). However, it is the examiner's opinion that the disclosure fails to disclose the claimed limitations wherein the user may select the bookmark so as to subsequently "provide signals containing said visual scene" in response to a "request said visual scene in said sequential visual media". The provisional application appears only directed towards the establishment of a bookmark and further fails to disclose or suggest claimed limitations pertaining to the particular configuration of the "client device" or "server device", the ability to "provide a character sequence describing said visual scene" by the user, or the claimed bookmark list access or maintenance functions. Accordingly, for the purposes of evaluation of prior art with respect to applicant's claim to priority to provisional application 60/170,302, the application filing date shall be the filing date of the instant

application or 20 October 2000. Applicant is reminded that in responding to the examiner's remarks pertaining the priority of claims to specifically point out how each and every claim is supported for the purposes of an assignment of a priority date.

2. With respect to applicant's claim for priority to US Pat. Application No. 09/590,488, the subject matter that is common between the two application appears to be related to the overall system architecture and ordering process as illustrated in Figures 1-6. Figure 19C of the earlier '488 application, appears to correspond to Figure 7 of the instant application. However, the earlier filed application does not appear to disclose or illustrate the "bookmark" process as claimed. Accordingly, the claimed subject matter of the instant application is to be evaluated on the basis of the filling date of the instant application or 20 October 2000.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 70 (Figure 3); 81 (Figure 4); 104, 107, 108 (Figure 5); 181, 183, 184 (Figure 13). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because label for element "109" should read "You've Got Mail". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following informalities:

- Reference to "application memory 100" should be amended to reference "application memory 70" (Page 8, Line 21);

Appropriate correction is required.

Claim Objections

6. Claim 9 is objected to because phrase "said scene in said contained in said video presentation" should be amended to read "said visual scene contained in a video presentation" in order to properly refer back to the recitation in Line 4. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the limitation "said feedback". There is insufficient antecedent basis for this limitation in the claim. For the purpose of further art evaluation, the examiner shall presume that the claim is to be dependent upon claim 10.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-5, 8-9, 12-15, 17, 20-23, 25, 28-31, 33, 36-39, 41, 44-45, 56, 62-65, and 74 are rejected under 35 U.S.C. 102(b) as being anticipated by Budow et al. (US Pat No. 5,625,864).

In consideration of claims 1-2, the Budow et al. reference discloses a method for providing "media" associated with video-on-demand services to a "user" via an "interactive media services client device" [15] that is coupled to a "programmable media services server device" [12/13]. The method "receiving a first user input associated with a visual scene contained in a sequential visual media" which establishes a "bookmark" whereupon the embodiment "stores information related to said visual scene in memory" (Col 4, Lines 44-58). The embodiment may subsequently "receive a second user input requesting said visual scene in said sequential visual media" so as resume playing a requested program from the book marked point whereupon the embodiment "provides the user with said visual scene in said sequential visual media" as well as "a portion of said sequential visual media that is subsequent to said scene" in conjunction with resuming playing the media from where the user left-off (Col 12, Lines 29-37).

Claim 3 is rejected wherein the aforementioned video information is displayed on a "television screen" [16].

Claim 4 is rejected wherein the visual media is a "video-on-demand presentation" (Col 5, Lines 18-20).

Claim 5 is rejected wherein a "user input" may be received via a "remote control device" [17].

Claim 8 is rejected wherein as aforementioned wherein the embodiment is operable to "receive a user input requesting that a visual scene contained in a video presentation be book marked", to "store information related to said visual scene in memory", to "receive a user input requesting that said visual scene be displayed" and to "provide the user with said visual scene" (Col 4, Lines 44-58; Col 12, Lines 29-37).

Claim 9 is rejected wherein the "user input" may be "received while said user is viewing said visual scene contained in a video presentation" whereupon the activation of the "bookmark" stops the presentation being viewed (Col 12, Lines 29-37).

Claims 12-13, 20-21, 28-29, and 36-37 are rejected wherein the "client device" [15] comprises the "means for storing information" or "memory" [407] and "processing means" or a "processor" [402] (Col 14, Line 55 – Col 15, Line 4). Similarly, the "server device" [12/13] comprises the "means for storing information" or "memory" and "processing means" in the form of a "processor" (Col 10, Lines 22-38; Col 12, Lines 48-64).

Claims 14, 22, 30, and 38 are rejected wherein the visual media is a "video-on-demand presentation" (Col 5, Lines 18-20).

Claims 15, 23, 31, and 39 are rejected wherein a "user input" may be received via a "remote control device" [17].

Claims 17, 25, 33, and 41 are rejected wherein the aforementioned video information is displayed on a "television screen" [16].

Claim 44 is rejected wherein "said memory is non-volatile memory" [407] (Col 14, Lines 63-65).

Claim 45 is rejected wherein the "user input" may be "received while said user is viewing said visual scene contained in a video presentation" (Col 12, Lines 29-37).

Claims 56 and 74 are rejected wherein "after expiration of a rental access period" of 24 hours or when the user checks out of the hotel, the embodiment may "disassociate said visual scene from said bookmark list" (Budow et al.: Col 12, Lines 37-40).

Claim 62 is rejected as aforementioned wherein the "system" comprises "bookmarking logic" to "cause bookmarking data" comprising "information related to a visual scene . . . that is identified via user input" by a remote control [17] to be stored in "memory" and "retrieval logic" so as to "transmit to a display device" [16] the aforementioned "visual scene" (Col 4, Lines 44-58; Col 12, Lines 29-37).

Claim 63 is rejected wherein the "client device" is a "television set-top box" [15] and the "display device is a television" [16].

Claim 64 is rejected wherein "said memory is non-volatile memory" [407] (Col 14, Lines 63-65).

Claim 65 is rejected wherein the "user input" may be "received while said user is viewing said visual scene contained in a video presentation" (Col 12, Lines 29-37).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 6, 16, 24, 32, 40, 46-47, 57, 66-67, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budow et al. (US Pat No. 5,625,864).

In consideration of claims 6, 16, 24, 32, and 40, the Budow et al. reference discloses usage of "options displayed on a display device" that may be selected via a "user input" (Col 11, Lines 62-65). The reference, however, does not explicitly disclose, nor preclude that restarting of a video presentation (Col 12, Lines 57-58) is necessarily one of the "options" performed through the aforementioned menu. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the user with such an "option" through the "display means" [16] for the purpose of ~~proving~~ providing the user with a user friendly method for selecting among various program control options in a manner that advantageously does not require for the remote control to have function specific buttons.

In consideration of claims 46-47 and 66-67, the Budow et al. reference discloses support for video play-type commands such as "stop" and "pause" operations (Col 4, Lines 48-52). The reference does not explicitly disclose nor preclude multiple points in the presentation in which the bookmark operation may be performed. It would have been an obvious matter of design choice to "receive" the "first user input" while a presentation is "paused" or "stopped", since applicant has not disclosed that the receiving the "first user input" during a particular presentation play state solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the "first input" being received during play, "stop", and/or "pause" operations. Subsequently, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Budow et al. embodiment so as to facilitate "receiving" the "first user input" regardless of the play state of the presentation for the purpose of providing a flexible means wherein a user may bookmark a presentation.

In consideration of claims 57 and 75, the combined references do not explicitly disclose nor preclude further "prompting said user to provide input as to whether said bookmark list is to be deleted". Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such functionality in conjunction with the Budow et al. embodiment for the purpose of providing the user with a friendly reminder that the bookmark is to be deleted and to subsequently provide the user with the opportunity to save it in conjunction with the renewal/extension of the rental period. Such a method may advantageously provide additional revenue to the provider.

14. Claims 7, 10-11, 18-19, 26-27, 48, 50-55, 58-61, and 68-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budow et al. (US Pat No. 5,625,864) in view of Swenson et al. (US Pat No. 6,064,380).

In consideration of claims 7, 18-19, and 26-27, the Budow et al. reference does not explicitly disclose nor preclude the means for further enabling the user to provide a "character sequence" as to name the bookmark. The Swenson et al. reference discloses a method for bookmarking video sequences for later playback that further "receives user input assigning a character sequence to said visual scene", "storing data corresponding to said character in memory" and "displaying said character sequence in associated with said visual scene" (Figure 3; Col 5, Lines 24-62). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Budow et al. reference to further provide a method by which the user may name a bookmark associated with a video as taught by Swenson et al. for the purpose of providing a means by which a user may advantageously associate a name or other identification with a particular segment for later retrieval (Swenson et al.: Col 2, Lines 23-41).

Claims 10 and 11 are rejected wherein as illustrated in Figure 3 of the Swenson et al. reference, the user "receives feedback confirming the insertion of a bookmark" in the form of an text based "icon displayed on a display device".

Claims 48 and 68 are rejected wherein the user is "provided" with a "confirmation that said visual scene has been bookmarked" as illustrated in Figure 3 of the Swenson et al. reference.

Claims 50 and 69 are rejected wherein the aforementioned "visual scene" is "associated with a bookmark list" as illustrated in Figure 3 of the Swenson et al. reference.

In consideration of claims 51 and 52, the embodiment is operable to "receive a second user input" wherein a "second visual scene contained in a video presentation be bookmarked" and associated with a "second bookmark list" as illustrated in Figure 3 of Swenson et al. The claim is not limiting such that the "second user" is necessarily a different user and as such may be performed by either the same or a different user as in claim 1. Alternatively, as the Budow et al. is a multi-user environment associated with a hotel (Figure 2), the first and second user may be different; each associated with a different room number.

Claims 53 and 71 are rejected wherein "after expiration of a rental access period" of 24 hours or when the user checks out of the hotel, the embodiment may "disassociate said visual scene from said bookmark list" (Budow et al.: Col 12, Lines 37-40).

In consideration of claims 54 and 72, the combined references do not explicitly disclose nor preclude that upon the "expiration of a rental access period said visual scene continues to be associated with said bookmark list" in so far as the bookmark list may be associated with multiple users. Subsequently, upon the expiration of a rental access period of a first user, the visual scene continues to be associated with said bookmark list of a second user. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combined references as to continue to associated a bookmark with a particular scene subsequent to the expiration period for the purpose of providing additional revenue sources to the provider. For example, by continuing to associate a particular scene with the bookmark list, the provider could subsequently provide the user

with the opportunity continue/finish watching the video from a particular point in conjunction with the renewal/extension of the rental period.

In consideration of claims 55 and 73, the combined references do not explicitly disclose nor preclude further "prompting said user to provide input as to whether said bookmark list is to be deleted". Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such functionality in conjunction with the Budow et al. embodiment for the purpose of providing the user with a friendly reminder that the bookmark is to be deleted and to subsequently provide the user with the opportunity to save it in conjunction with the renewal/extension of the rental period. Such a method may advantageously provide additional revenue to the provider.

In consideration of claims 58-60, the as aforementioned the Budow et al. reference does not explicitly disclose nor preclude multiple points in the presentation in which the bookmark operation may be performed. It would have been an obvious matter of design choice to "receive" the "first user input" while a presentation is "playing" or "paused" or "stopped", since applicant has not disclosed that the receiving the "first user input" during a particular presentation play state solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the "first input" being received during "play", "stop", and/or "pause" operations. Subsequently, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Budow et al. embodiment so as to facilitate "receiving" the "first user input" regardless of the play state of the presentation for the purpose of providing a flexible means wherein a user may bookmark a presentation.

In consideration of claim 61, as aforementioned, the combined reference do not explicitly disclose nor preclude that a "character sequence" may not be assigned/received "after a presentation of said sequential visual media has ended". However, it would have been an obvious matter of design choice to "assign"/"receive" the sequence at the "end" of the presentation, since applicant has not disclosed that assignment timing solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the assignment of a character sequence being during any point in the presentation. Subsequently, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Budow et al. embodiment so as to facilitate "receiving"/"assigning" the aforementioned "character sequence . . . after a presentation of said sequential visual media has ended" for the purpose allowing the user to assign a "character sequence" at a later point so as to not disturb the user with such during the presentation. Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the ability to "assign a character sequence . . . after a presentation of said sequential visual media has ended" for the purpose of advantageously providing the user with the ability to rename presentation bookmarks.

Claim 70 is rejected wherein the "bookmark list" may be stored in "memory" (Swenson et al.: Col 5, Lines 24-62).

15. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Budow et al. (US Pat No. 5,625,864) in view of Wang (US Pat No. 6,501,902).

In consideration of claim 49, the Budow et al. reference does not explicitly disclose nor preclude that the particular selection of a bookmark may further "correspond to a selection of

a thumbnail image". The Wang reference discloses a method wherein "selectable" bookmarks may be represented by "thumbnail images" (Figure 3). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Budow et al. reference to further utilize "thumbnail images" to represent bookmarks for the purpose of providing a visual reminder of the particular scene associated with the bookmark using a visual manner that is not confusing the user (Wang: Col 1, Lines 44-60).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Dunn et al. (US Pat No. 5,861,906) reference discloses a VOD application that allows viewers to create their own customized lists of preferred video content.
- The LaJoie (US Pat No. 5,850,218) reference discloses a system and method for providing a full service cable television system that facilitates video-on-demand services.
- The White (US Pat No. 6,628,302) reference discloses a method for distributing interactive programming through a distribution network to client terminals.
- The Vallone et al. (US Pat No. 6,642,939) reference discloses a PVR that facilitates the programming/usage of bookmarks.

- The Goode et al. (US Pat No. 6,166,730) reference discloses a video-on-demand system that utilizes bookmarks in order to facilitate the restarting of a video session.
- The Gordon et al. (US Pat No. 6,208,335) reference illustrates the GUI utilized by the aforementioned Goode et al. reference in more detail.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-HELP.

SEB
November 25, 2003

JOHN MILLER
SUPERVISORY PATENT EXAMINER
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